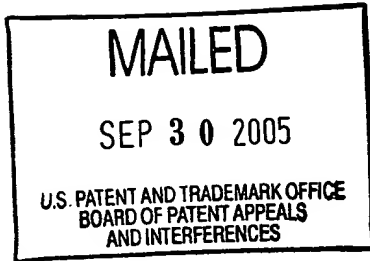


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KONSTANTINOS POULAKIS
and AXEL SCHULTE

Appeal No. 2005-1712
Application No. 09/743,710

ON BRIEF

Before HANLON, KRATZ and TIMM, Administrative Patent Judges.

HANLON, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of this record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application for the examiner to consider the following issues and take appropriate action.

I.

Claims 9-18 are involved in this appeal¹ and are directed to a method for producing a foam body part, such as a foam padding element for a vehicle seat. Claim 9 is illustrative and reads as follows:

¹ In the Office Action Summary attached to the Examiner's Answer, the examiner indicates that claim 19 is allowed.

9. A method for producing a foam body part having at least one adhesive closing part with adhering elements, comprising the steps of:

arranging an adhesive closing part in a foaming mold for forming a foamed body part, the adhesive closing part having first and second opposite surfaces and having adhering elements extending from said first surface;

protecting the adhering elements on the adhesive closing part against penetration of foam by arranging a foam-inhibiting covering on said second surface of the adhesive closing part to be remote from the adhering elements, the foam-inhibiting covering having a predetermined peripheral border width overlapping and extending beyond a surface area of the adhering elements; and

bringing the foam-inhibiting covering into detachable contact with parts of the foaming mold by permanent magnets in parts of the foaming mold attracting a ferromagnetic coating extending throughout the entire length and width of the foam-inhibiting covering, the permanent magnets being placed laterally about a periphery of a portion of the foaming mold receiving the adhering elements of the adhesive closing part to cooperate with the peripheral border of the covering overlapping the surface area of the adhering elements.

The following objection and rejections are at issue in this appeal:²

(1) The amendment filed on January 15, 2003, is objected to under 35 U.S.C. § 132 because it introduces new matter into the disclosure.

(2) Claim 9 is rejected under 35 U.S.C. § 112, first paragraph, based on written description.

²According to MPEP § 608.04(c) (8th ed., Rev. 2, May 2004), where new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. However, where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though the new matter has also been introduced in the specification. In this case, the appellants' amendment to the specification affects the claims. Therefore, the objection is properly before the Board.

(3) Claims 9-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Billarant³ and Provost.⁴

II.

The amendment filed on January 15, 2003, was objected to under 35 U.S.C. § 132 because, according to the examiner, it introduced new matter into the specification and claim 9. Answer at 3-4. Claim 9 was also rejected under the written description requirement of 35 U.S.C. § 112, first paragraph, for the substantially the same reasons set forth by the examiner in the objection. See In re Rasmussen, 650 F.2d 1212, 1215, 211 USPQ 323, 326 (CCPA 1981) (past opinions of this court, in cases in which a claim rejection under 35 U.S.C. § 132 was reviewed using a 35 U.S.C. § 112 analysis, should not in future be viewed as having approved the employment of 35 U.S.C. § 132 as a basis for claim rejection; the amended claims involved in those cases should have been rejected under 35 U.S.C. § 112, first paragraph); see also MPEP § 706.03(o) (8th ed., Rev. 2, May 2004).

In the amendment, paragraph [0017] of the substitute specification was amended, in part, to read as follows:

[0017] The tight connection of adhering elements 5 with covering element 15, varying from the diagrammatic representation of Fig. 3A, can also occur directly through a polyurethane coating containing ferromagnetic substances. Such coating can be for example the polyurethane SU-9182 of Stahl Holland B.V. of

³ U.S. Patent No. 5,422,156 issued on June 6, 1995, to Billarant.

⁴ International Publication No. WO 86/03164 published on June 5, 1986, and naming Provost, et al. as inventors.

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Waalwijk Holland, the subject matter of which is hereby incorporated by reference. [Underlining added.]

The examiner indicates that the new matter in the specification is the phrase, “the subject matter of which is hereby incorporated by reference,” and the new matter added to claim 9 is the phrase, “a ferromagnetic coating extending throughout the entire length and width of the foam-inhibiting covering.” Answer at 3-4.

On appeal, the appellants argue that the phrase, “the subject matter of which is hereby incorporated by reference,” merely specifies what is implicit in the original disclosure. For support, the appellants rely on a publication identified as “the SU-9182 publication” which is said to describe “SU-9182” and “the use of the Stahl SU-9182 product as the covering, including the ferromagnetic particles extending throughout its length and width” See Brief at 6-7.

The publication was said to have been submitted with an amendment filed on or about May 29, 2002. Brief at 7-8. However, we have not been able to locate the publication in the image file wrapper of the application. In order to understand the nature of the product identified as “SU-9182,” it is necessary to review the publication relied on by the appellants.⁵

Therefore, upon return of the application to the jurisdiction of the examiner, the examiner should obtain a copy of the publication, from the appellants or otherwise, and enter it into the official file wrapper of the application. If the document is in a language other than English, the

⁵ The examiner correctly points out that “essential material,” may not be incorporated by reference to non-patent publications, and the mere reference to a publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. § 112, first paragraph. See MPEP § 608.01(p) (7th ed., Rev. 1, Feb. 2000).

examiner should also obtain a certified English translation of the document and enter the translation into the official file wrapper of the application.

III.

We further note that the original disclosure does not describe “SU-9182” as “the polyurethane SU-9182 of Stahl Holland B.V. of Waalwijk Holland.” See amendment to paragraph [0017] of the substitute specification filed on January 15, 2003. Rather, in the original disclosure, the appellants use the designation “polyurethane SU-9182 of Firma Stahl.” See, e.g., Specification filed on January 16, 2001, at 5, lines 23-24.

Based on the record before us, it is unclear whether the two products are the same. Cf. MPEP § 608.01(v) (7th ed., Rev. 1, Feb. 2000) (explaining that the formula or characteristics of a product may change from time to time and yet it may continue to be sold under the same trademark). Upon return of the application to the jurisdiction of the examiner, the examiner should consider whether the description of “SU-9182” as “the polyurethane SU-9182 of Stahl Holland B.V. of Waalwijk Holland” is new matter.

IV.

Finally, as pointed out above, claim 9 is rejected under 35 U.S.C. § 112, first paragraph, based on written description. Upon return of the application to the jurisdiction of the examiner, the examiner should consider whether claims 10 through 18 should also be rejected under the written description requirement of 35 U.S.C. § 112, first paragraph, since claims 10 through 18 are dependent on claim 9. As explained in 37 CFR § 1.75(c) (2004), “Claims in dependent form

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